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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09.603,665	06/23/2000	Caroline Barry	GENSET.063AUS	8150

27206 7590 05/17/2002

GENSET
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EXAMINER

CHUNDURU, SURYAPRABHA

ART UNIT	PAPER NUMBER
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1637

DATE MAILED: 05/17/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/603,665

Applicant(s)

BARRY ET AL.

Examiner

Suryaprabha Chunduru

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 06 March 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-78 is/are pending in the application.
- 4a) Of the above claim(s) 1-45, 48-64, 76 and 78 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 46, 47, 65-75 and 77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other _____

DETAILED ACTION

1. Applicants' response to the office action and amendment (Paper No. 11) filed on March 6, 2002 has been entered.

Response to Arguments

2. Applicant's response to the office action (Paper No.11) is fully considered and deemed persuasive in part.

3. The rejection made under 35 U.S.C. 112 second paragraph in the previous office action is withdrawn herein in view of the applicants' amendment (Paper No.12).

4. The arguments and request for considering claims 76 and 78, have been fully considered but are found not persuasive because (1) they are new claims not originally presented and are classified in a separate classification. Further, this is not found persuasive because of the following reasons: (i) separate classification (including additional subclass 7.2) search is prima facie evidence of burden, (ii) art for the composition claims will not necessarily apply to the method of binding and vice versa, (iii) the issues are not the same with respect to 35 U.S.C. 112 and 35 U.S.C. 101 statutes, (iv) separate Art Units would examine the two Groups under ordinary circumstances. Further it is noted that 435/ 7.2 is one of the, if not the largest, subclass in the PTO with over 8,000 patents.

5. The following is the rejection made in the previous office action under 35 U.S.C. 102(b):

Claims 46-47, 65-75 and 77 are rejected under 35 U.S.C. 102(b) as being anticipated by Bowcock et al. (WO 9812327A2).

Bowcock et al. teach a composition of a purified or recombinant polypeptide which comprises at least 6 contiguous amino acids with (i) at least 1 amino acid position is substituted (see page 6,

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lines 19-22, page 286-288, SEQ ID No. 52, and sequence alignment, Geneseq database); the polypeptide with at least 20, 50, or so amino acids in length and 10 contiguous amino acids with amino acid substitutions (see page 9, lines 14-15, page 286-288, SEQ ID NO. 52 and sequence alignment, Geneseq database). Bowcock et al. also disclose antibody, which specifically binds to an epitope of binding proteins of human BAP28 sequence (see page 94, lines 28-32). Further Bowcock et al. disclose recombinant vector comprising the BRCA1- associated polypeptides, host cells and a method for producing the proteins or peptides (see page 23, lines 4-30) and pharmaceutically acceptable carriers (see page 129, lines 6-22). Thus the disclosure of Bowcock et al. meets the limitations in the instant claims.

Response to Arguments

Applicant's arguments with respect to the rejection made under U.S.C. 102(b) to claims 46-47, 65-75, and 77 have been considered and are found not persuasive. Applicants argue that the composition claimed is distinct from the composition in the prior art. This argument is unavailing for two reasons. First, the prior art references teach each of the limitations found in the claims. Second, the claim is of the open "comprising" format, which permits the inclusion of additional elements, so that any additional steps are permitted in the claim.

Applicants' particular argument that recombinant or isolated or purified polypeptide comprising at least 6 contiguous amino acids is not taught by the prior art of the record, is found not persuasive because Bowcock et al (WO 9812327 A2) teaches a recombinant polypeptide comprising 10 contiguous amino acids (Which includes 6 contiguous amino acids) and illustrates this "comprising" issue. In response to applicant's argument that the references would

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not accomplish the instantly claimed methods producing polypeptides and antibodies that specifically binds to the epitope, it is noted that the feature upon which applicant relies (specifically binds to epitope) is indeed cited in the prior art. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore the rejection is maintained herein.

No claims are allowable.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the


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examiner should be directed to Suryaprabha Chunduru whose telephone number is 703-305-1004. The examiner can normally be reached on 8.30A.M. - 4.30P.M, Mon - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 703-308-1119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-0294 for regular communications and - for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


Suryaprabha Chunduru
May 7, 2002


JEFFREY FREDMAN
PRIMARY EXAMINER